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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,217	12/12/2001	Thomas Raschke	Beiersdorf 754-KGB	8909
27384	7590	03/24/2004	EXAMINER	
KURT BRISCOE NORRIS, MC LAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/021,217	RASCHKE ET AL.
Examiner	Art Unit	
Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 10-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 10-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 10-20 are pending. The Amendment filed 11/13/03, cancelled claims 1-9 and added claims 10-20.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/03 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A composition, wherein the active ingredient consists of (a) and (b) is new matter. Applicant directs the Examiner to page 9, 3<sup>rd</sup> paragraph and page 10 of the specification for support. However, the Examiner finds no support in the instant specification for this claim limitation. The instant specification nowhere conveys that (a) and (b) are the only active

ingredient in the instant inventive compositions. Additionally, none of the instant examples exemplify a composition wherein (a) and (b) are the only active ingredients.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/37282. See US 6,503,518, which is an English language equivalent, as verified by a USPTO translator, of WO 99/37282, for citation purposes.

The instant invention is directed toward a composition comprising an aqueous phase, a lipid phase, and an active ingredient consisting of a combination of one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and alpha-lipoic acid. The instant invention is further directed to applying such a composition to the skin.

US 581 is directed to cosmetic and dermatological compositions that comprise one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid (abstract). US '518 discloses at column 4, lines 51-53 that the compositions preferably contain antioxidants. Lipoic acid is disclosed as a suitable antioxidant at column 4, lines 58-65. For glyceryl stearate citrate as a partially neutralized ester of monoglycerides and/or diglycerides of saturated fatty acids with citric acid within the instant claimed concentration ranges and oil-in-water emulsions see the examples beginning at column 8. See also claims 1

and 2. For lotions and creams see col. 6, lines 34-41. For gels see col. 10, line 54. Antioxidants (lipoic acid) are taught as comprising 0.001-30% of the composition and glyceryl stearate citrate (part (a) of the instant claims) is exemplified as comprising 3% of the composition. Thus the ranges of "(b)/(a)" of the instant claims are met by the teachings of US '581.

US '518 does not explicitly teach one composition comprising both one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and alpha-lipoic acid or application to the skin. However, US '518 teaches compositions comprising one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and antioxidants, wherein lipoic acid is taught as an antioxidant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a composition comprising one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and alpha-lipoic acid because of the expectation of achieving a composition that is particularly advantageous (see Col. 4, lines 51-57) and because of the expectation of achieving enhanced stability.

US '518 does disclose that lipoic acid can be added to the composition for its antioxidant properties. Nothing unobvious is seen in substituting the known claimed isomer for the compound of US '518 since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. It is well-known and common practice to apply cosmetic and dermatological compositions to the skin. Therefore, application of the composition to the skin as instantly claimed is not considered patentable over the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the composition of US '518 using any isomer of lipoic acid and apply it to the skin expecting to obtain a cosmetic and dermatological composition with antioxidant properties.

It is respectfully pointed out that US '518 teaches a composition comprising (a), an aqueous phase, and a lipid phase. The reference additionally teaches that antioxidants, such as lipoic acid (component (b) of the instant invention), can be added to the composition. Thus, US '518 teaches a composition comprising an aqueous phase, a lipid phase, and an active ingredient, wherein the active ingredient consists of (a) and (b).

***Response to Arguments***

Applicant argues that unexpected results have been achieved as a result of the combination of (a) and (b). However, Applicant provides no data to substantiate such results.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER